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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,849	07/09/2001	Morris C. Buenemann JR.	101960-200	1534

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WIGGIN & DANA LLP
ATTENTION: PATENT DOCKETING
ONE CENTURY TOWER, P.O. BOX 1832
NEW HAVEN, CT 06508-1832

EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 07/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,849

Applicant(s)

ROBINSON ET AL.

Examiner

George P Wyszomierski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 20-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-19 and 29-35 is/are rejected.
- 7) ☒ Claim(s) 2 and 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-14, 17-19, 29-31, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neumann (U.S. Patent 3,597,188).

Neumann discloses a process of obtaining substantially spherical shot by water atomizing a molten iron material followed by a heat treatment to decarburize the shot. Column 3 of Neumann further discloses separating the various shot particles by size and subjecting only a desired size range of the particles to further processing. Neumann does not specify the particular size ranges as recited in several of the instant claims, and does not specify that a particular hardness though only a certain percentage of the thickness of the particles is obtained by the decarburizing step. These differences are not seen as resulting in a patentable distinction between the prior art process and that presently claimed because:

a) With regard to particle sizes, the various sizes as recited in column 3 of Neumann overlap those recited in the instant claims, and thus the Neumann process appears amenable to the production of shot of the presently claimed size(s).

b) Given that the actual process steps of Neumann involve subjecting substantially the same material to substantially the same set of manipulative steps as is done in the present invention, it stands to reason that the same hardness values, in all or part of the final product materials, would likewise be achieved in both instances.

Consequently, a prima facie case of obviousness is established between the Neumann disclosure and the presently claimed invention.

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3. Claims 15, 16, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neumann, as above, in view of Arvidsson (U.S. Patent 6,027,544).

The Neumann patent does not discuss manufacturing compositions as set forth in the instant claims. Arvidsson indicates that it is conventional in the art to manufacture compositions as presently claimed by a method which includes water atomization followed by a heat treatment to decarburize the material, i.e. by a method substantially in accord with that done by Neumann. In particular, note column 2, lines 54-56 and column 3, lines 61-65 of Arvidsson. This disclosure of Arvidsson would have motivated one of ordinary skill in the art to form shot of the presently claimed composition using the method as disclosed by Neumann.

4. In a response filed June 16, 2003, Applicant alleges that the examiner appears to concentrate on the atomization and decarburization steps of Neumann, that the claimed process is drawn to the production of material having a size, roundness, and/or hardness distinct from that of Neumann, that the composition used in Arvidsson is different from that of Neumann, and/or that certain information contained in a declaration filed by one of the inventors in the parent application (S.N. 09/329,475) supports patentability of the presently claimed invention. Applicant's arguments have been carefully considered, but are not persuasive of patentability because:

a) Applicant is correct that the examiner has focused on the atomization and decarburization steps of Neumann, for the reason that these steps are those that are recited in each of the present independent claims. The instant claims are to a series of process steps, and such a series of steps is disclosed in the Neumann reference, as stated in the rejection supra.

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b) With respect to size, roundness, and hardness, the present claims simply state that the claimed process produces material "for discharge from a shotgun", and this definition results in no specific limitation on the precise size and shape of the material. Users of different shotguns used at different times for various purposes may find the prior art materials "useful" for their purposes. It is further noted that the instant claims define the material as "spheroidal", in accord with the term "spherical" as disclosed in column 2 of Neumann.

c) While the composition of Arvidsson differs to some degree from that of Neumann, both compositions are iron-based powders containing such alloying elements as carbon, manganese, and silicon, and both are subjected to a decarburizing process. The Arvidsson patent was cited to show that it was known in the art, at the time of the invention, to produce a variety of iron-based compositions by an atomization and decrburization method.

d) With regard to the Rule 132 declaration, this declaration has been given little weight in determining patentability of the present invention. First, the original purpose of the declaration in the parent application was to overcome rejections based on a number of prior art documents (see paragraph 9 of the declaration), but none of these documents are applied against the instant claims. Second, Declarant states that some level of roundness was achieved in his experience in working with various shot making methods, but no indication is given that any roundness level associated with the present claims is in any way distinct from that achieved in the applied prior art. Most importantly, the evidence of commercial success supplied in the Declaration is of little

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relevance to the present invention. The present claims are to a method and not to any particular product sold in the marketplace. Further, it would appear that an commercial success is due largely to pricing of the products described in the exhibits attached to the declaration, and Declarant in fact states on the second line of page 4 of the declaration that many of the potential customers of these products "are particularly cost-conscious". The examiner's interpretation of this is that most, if not all, of any commercial success achieved by Applicants is the result of the prices charged for their products versus those of their competitors, and not due to any novelty or variation in the methods which may have been used to make these products. In this respect, the examiner emphasizes that all of the instant claims are drawn to a method, and nothing in the Declaration would indicate any distinctness in the claimed method versus those of the applied prior art (Neumann and/or Arvidsson).

5. Claims 2 and 3 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not disclose or suggest a process as presently claimed and which includes packaging the pellets or loading the pellets in a manner as defined in these claims.


6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (703) 308-2531. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (703) 308-1146. The fax phone number for this Group is (703) 872-9310 for all correspondence except for After Final amendments in which case the Fax number is (703) 872-9311. The Right fax number for this examiner is (703) 872-9039. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW
June 23, 2003